PATENT

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Lisa L. Pringle
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THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Henry Frank Gasbarro, et al.
Serial No.	:	10/634,295
Filing Date	:	5 August 2003
For	:	DISMOUNT TABLET COMPUTER ASSEMBLY FOR WIRELESS COMMUNICATION APPLICATION
Group Art Unit	:	7971
Examiner	:	Brian J. Broadhead
Attorney Docket No.	:	NG(MS)6620

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Commissioner for Patents
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Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Advisory Action filed in this case on September 6, 2006, please enter and consider the following remarks

Remarks/Arguments begin on page 2 of this paper.

REMARKS

Claims 1-7 and 9-25 are currently pending in the subject application, and are presently under consideration. Claims 1-7 and 9-25 are rejected. Favorable reconsideration of the application is requested in view of the comments herein.

I. Rejection of Claims 1-7, 9, 11-16 and 20-25 Under 35 U.S.C. §103(a)

Claims 1-7, 9, 11-16 and 20-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,278,402 to Pippen ("Pippen") in view of U.S. Patent No. 5,952,959 to Norris ("Norris").

To support a conclusion of obviousness, the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex Parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).*

The Examiner admits that neither Norris nor Pippen disclose at least the following 9 elements recited in the claims: an L-band transceiver (Claims 1-7. 9. 11-15) a satellite relay (Claims 1-7. 9. 11-25), power regulating I/O device (Claim 4), a touch screen display (Claim 5), a detachable antenna (Claim 6), a quadrifilar helix antenna (Claim 7), a faraday cage (Claim 9), or a heat sink (Claim 10), and means for software to control power consumption (Claims 23-25).

However, the Examiner states, "Official Notice is given that one of ordinary skill in the art would exchange the portable device with a tablet device; and any type of wireless communication including L-band is known in the art and advantages are known. Tablet PCs include software and hardware to control power usage just like laptop. It would have been obvious to one of ordinary skill in the art to use the items in the previous sentence along with a detachable antenna, a faraday cage, and a heat sink because it is design choice. The advantages of using all these items are known in the art".

'The mere fact the art can be rearranged the parts of the reference devices to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). The Examiner has not provided specific reasons of how and why one skilled in the art would desire to make the proposed modification of Pippen and Norris to make obvious the claims of the present invention, and therefore has not established a prima facie case of obviousness.

It appears that office action relies solely on the Examiner's personal knowledge that Pippen in view of Norris, when modified, with the 9 elements in which the Examiner takes official notice would make obvious the claims of the present application. Applicant pursuant to 37 C.F.R. §1.104(d)(2), requested an affidavit of the Examiner to support the Examiner's statement. In response, the Examiner cites 14 references without showing one instance of suggestion or motivation for combining these references to make obvious claims 1-7, 9, 11-16 and 20-25. Additionally, in the Advisory Action dated September 6, 2006 the Examiner cites an

article illustrating power schemes for a tablet PC, but again provides no explicit suggestion or motivation for the proposed combination.

The applicant's representative, therefore, requested that the Examiner provide some evidence of suggestion or motivation in the cited references or to that of ordinary skill in the art to support the proposed motivation or suggestion to combine the references to make obvious the 9 elements that the Examiner is taking official notice. Absent some support by evidence or technical reasoning, the Examiner's statement are at best mere speculation. It is well settled that speculation is not sufficient for establishing a prima facie case of obviousness. *Ex parte Yamamoto, 57 USPQ2d 1383, 1384 (Bd. Pat. App. & Inter. 2001)*, citing *In re Warner, 154 USPQ 173, 178 (CCPA 1967)*. Thus, without some basis in fact or technical reasoning to support the Examiners statement, the Office Action has failed to establish prima facie case of obviousness and withdrawal of the rejection is respectfully request.

Furthermore, the Examiner states in the Final Office Action that "Norris teaches broadcasting location information from the at least one portable device through a relay network and receiving location information from the at least one portable device via the relay network". Norris specifically discloses that the second GPS device has a receiver for receiving transmitted data and location from the first GPS device via a transmitter of the first GPS device (See Norris FIG. 8 description). In the Advisory Action dated September 6, 2006, the Examiner retracts this statement, and states, "Later in the rejection the limitation of the satellite relay is addressed". Applicant's representative disagrees. No where in either the first office action September 28, 2005, the final office action dated June 15, 2006 or the advisory action dated September 6, 2006 does the Examiner address a relay network or a satellite relay. Neither Pippen nor Norris teach or suggest the use of a satellite relay network to transmit and receive location information between portable devices, as recited in claims 1-7, 9-25.

In the Advisory Action, the Examiner repeatedly states that "A combination of known elements in the prior art is a design choice absent some showing of and unexpected result". This is simply not the law that 35 USC §103 is based. The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some "teaching, suggestion, or reason" to combine cited references. When the art in question is relatively simple, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously in such situations. *McGinley v. Franklin Sports, Inc., 00-1324, 01-1113, UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, 262 F.3d 1339; 2001 U.S. App. LEXIS 18758; 60 U.S.P.Q.2D (BNA) 1001, August 21, 2001, Decided, Rehearing and Rehearing en banc Denied October 17, 2001, Reported at: 2001 U.S. App. LEXIS 24254.*

Pippen discloses a system for providing differential GPS techniques to golfers to find points of selected interest on a golf course with precision. Differential GPS techniques are employed to correct for inaccuracies in GPS positioning data that is provided to commercial users worldwide. Norris discloses finding the relative position of two devices in spite of the

error (Selective Availability) that was once introduced into the GPS network to reduce the accuracy of the GPS network for nonmilitary users. In the Norris system, the position of a first device is transmitted directly via a transmitter to a second device via a receiver, and the relative location of the devices is determined by subtraction, thus eliminating the common Selective Availability (SA) error associated with the commercial GPS.

It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983) Norris teaches a mechanism for circumventing the inaccuracies of commercial GPS by finding relative positions between two GPS devices, and specifically discloses a method that eliminates the need for a permanent GPS system to provide for GPS error correction (Norris Col. 6, ll. 25-40). Pippen employs a central permanent base station to generate a GPS correction signal that is a function of the surveyed base station location and a GPS derived base station location (Pippen Col. 11 ll. 6-32). Therefore, Norris and Pippen teach away from the proposed modification.

Furthermore, modifying the differential GPS system of Pippen with the relative system of Norris would render Pippen unsatisfactory for its intended purpose, and change the principle operation of Pippen, which is a differential GPS system to correct for the inaccuracies of commercial GPS and to provide a precise GPS location. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).* If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).*

For the reasons described above, the Examiner has not establishes a prima facie case obviousness and claims 1-7, 9, 11-16 and 20-25 should be patentable over the cited art. Accordingly, withdrawal of this rejection is respectfully requested.

II. Rejection of Claim 10 Under 35 U.S.C. §103(a)

Claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Pippen in view of Norris as applied to claim 9, and further in view of U.S. Publication No. 2003/0017646 to Sridharan, et al. ("Sridharan").

The Examiner admits that neither Pippen nor Norris disclose the limitations of claim 10. The Examiner cites Sridharan disclosing a faraday cage as a heat sink to make obvious claim 10. Shridharan discloses a ball grid array package that includes an external faraday cage formed around an integrated circuit. The Examiner states that it would be obvious to one of ordinary skill in the art at the time the invention was made because it would limit interference while utilizing internal chip structures which would decrease costs. Applicant's representative disagrees with this asserted suggestion or motivation. Shridharan discloses a ball grid array package or integrated circuit. There is no suggestion or motivation in Shridharan to modify Pippen nor Norris to include a Faraday cage that surrounds a L-band transceiver that is

configured operate as a heat sink to draw heat from the transceiver away from the processing unit, as recited in claim 10. There is no discussion of a practical use of internal chip structures in either the present application, Pippen or Norris. Additionally, Shridharan is non-analogous art in that one skilled in the art would not look to ball-grid arrays to solve the high power heat problem and frequency sensitivity of the tablet computer assembly with satellite transmission capabilities. *Wang Laboratories, Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).*

For the reasons described above, claim 10 should be patentable over the cited art. Accordingly, withdrawal of this rejection is respectfully requested.

III. Rejection of Claims 17-19 Under 35 U.S.C. §103(a)

Claims 17-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Pippen in view of Norris as applied to claim 16, and further in view of U.S. Publication No. 2005/003253 to Kokkonen, et al. ("Kokkonen").

The Examiner admits that neither Pippen nor Norris disclose the limitations of claim 17. The Examiner cites Kokkonen to disclose encoding routing information to make obvious claim 17. No where does Kokkonen disclose encoding routing information. Kokkonen discloses verifying and initiating provision of location information that is associated with a target user based on determining if identifying information in the request is associated with someone authorized to receive the location information. None of the signaling, the request or the location information is encoded. The Examiner states in the Advisory Action of September 6, 2006 that Kokkonen discloses an identifier, but fails to show why this is relevant to the claimed encoded routing information. Additionally, there is no motivation or suggestion in Kokkonen to modify Pippen or Norris to encode data transmission in the GPS devices for use in a golf course setting. Therefore, one skilled in the art would not be motivated to encode and secure the transmission of points on the golf course from other golfers.

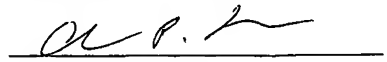
For the reasons described above, claims 17-19 should be patentable over the cited art. Accordingly, withdrawal of this rejection is respectfully requested.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application and that the application be passed to issue.

Please charge any deficiency or credit any overpayment in the fees for this amendment to our Deposit Account No. 20-0090.

Respectfully submitted,



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